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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:

Jonnie R. WILLIAMS

U.S. Patent 6,202,649
(Serial No. 09/397,018
filed September 15, 1999)

For: METHOD OF TREATING TOBACCO TO
REDUCE NITROSAMINE CONTENT, AND
PRODUCTS PRODUCED THEREBY

Group Art Unit: 1731

Examiner: M. Colaianni

Atty. Dkt. No.: 04859.84

Atty. Dkt. No.: 04859.84703

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OFFICE OF PETITIONS

SUBMISSION UNDER 37 C.F.R. § 1.28

The Honorable Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This paper is being filed pursuant to 37 C.F.R. § 1.28 to pay the difference between the Issue Fee previously paid in the small entity amount and the current Issue Fee amount for a non-small entity in the above-captioned patent.

Statement of Facts

1. During August 2000, Regent Court Technologies (at all times assignee) and Star Tobacco & Pharmaceuticals, Inc. (then the exclusive licensee) entered into a restated loan agreement with Brown & Williamson Tobacco Corporation ("B&W"). In connection with the restated loan agreement, Regent Court Technologies ("Regent Court") and Star Tobacco & Pharmaceuticals, Inc. ("Star") granted to B&W a security interest. As a security interest, B&W could exercise a royalty free license to practice the invention of the subject application only upon an uncured default in the loan agreement on the part of Regent Court or Star.

2. The undersigned was unaware of the August 2000 security interest granted to B&W at the time the Issue Fee was paid on September 18, 2000, so that any possible relevance of that security interest was not considered. The Issue Fee was paid on the basis of small entity status, a status which was applicable to both Regent Court and Star as small business concerns.

3. The undersigned believes that at the time the Issue Fee was paid, B&W, though clearly not a small business concern, did not own "rights in the invention" within the meaning of 37 C.F.R. § 1.27(a)(2)(i), i.e., "those [rights] in the United States to be covered by the application or patent." M.P.E.P.

09/04/2001 MBERHE1 00000036 190733 09397018

01 FC:242 15.00 CH 605.00 OP
02 FC:561 15.00 CH

§ 509.02. It is believed that the payment of the Issue Fee in the small entity amount was appropriate under 37 C.F.R. § 1.27(a)(2) because each entity then owning rights in the invention qualified as a small business concern.

4. Nonetheless, out of an abundance of caution and to put any possible later challenge to rest, Applicant wishes to withdraw its claim to small entity status and hereby authorizes payment of a full Issue Fee in the subject patent.

Payment of Deficiency Owed Pursuant to 37 C.F.R. § 1.28(c)(2)(ii)

Please charge \$ 635 for the Issue Fee deficiency to our Deposit Account 19-0733. The deficiency in the Issue Fee is calculated as follows:

<u>Current Issue Fee for Non-Small Entity</u>	<u>Issue Fee Previously Paid</u>	<u>Deficiency Owed</u>
\$ 1240	\$ 605	\$ 635

If the calculated amount is incorrect, the Director is authorized to charge any deficiency or credit any overpayment to our Deposit Account 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: August 30, 2001

By: 
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